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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/705,344

11/10/2003

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116 7590 09/10/2009
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EXAMINER

GEHMAN, BRYON P

ART UNIT

PAPER NUMBER

3728

MAIL DATE

DELIVERY MODE

09/10/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/705,344	Applicant(s) SAHO, HIDEHIRO	
	Examiner Bryon P. Gehman	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3, 13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/28/04, 7/2/08+1/5/09</u> . | 6) <input type="checkbox"/> Other: _____ |

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 20 August 2009 has been entered.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 3, line 31, "a feed hole" is indefinite, as feed holes have been previously defined, and it is not clear if this is one of previously defined feed holes or an additional different one.

In claim 14, lines 4-5, "the regular feed hole" lacks antecedent basis.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 3 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 3311634. Disclosed is an electronic part supplying tape comprising a first tape member (9) with a first end portion and a second end portion, and a second tape member (10) with a first end portion and a second end portion having a first connecting portion (vertical walls of endmost 3) formed on the second end portion of the first tape member, and a second connecting portion (vertical walls of endmost 3) formed on the first end portion of the second tape member, the connecting portions to be connected, an alignment means (8) for positioning the first and second connecting portions in a longitudinal direction, a width direction and a thickness direction of the tape members, and a holding means (13) for holding the first and second connecting portions to each other, wherein the first and second tape members are connectable by connecting the first connecting portion of the first tape member and the second connecting portion of the second tape member, wherein the first connecting portion of the first tape member comprises a locking member attachment (13 engaging 3 of 9) coupled to the second end portion of the first tape member, and the second connecting portion of the second tape member comprises a locked member attachment (13 engaging 3 of 10) coupled to the first end portion of the second tape member, wherein the locking member attachment and the locked member attachment constitute the alignment means, wherein each tape member having a plurality of recessed portions (3) formed at a constant pitch and a plurality of feed holes (15) formed at a constant pitch for feeding

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the tape member, wherein another feed hole (hole intersected by 7 in Figure 2) is provided on the locking member attachment and locked member attachment in a positional relationship corresponding to the other feed holes of the tape members.

As to claim 14, the feed hole provided on the locking and locked member attachments is at a position at which a positional relationship of the feed hole with a contiguous feed hole corresponds with the regular feed holes of the tape members when the tape members are engaged.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hamano (EP 07165260) in view of Busler (3,431,548). Hamano discloses an electronic part supplying tape comprising multiple tape members each having a first connecting portion (one end of a described tape piece), and a second connecting portion (the other end of the described tape piece), an alignment means (portions K and K), and a holding means (portions received in portions K and K), the tape members each having a plurality of recessed portions (cavity parts) formed at a constant pitch and a plurality of feed holes (6) formed at a constant pitch for feeding the tape member, with the feed holes extending the entire length of the tape member. Busler discloses a first connecting

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portion (at 44), and a second connecting portion (at 46), an alignment means (43, 44 and 48, interengaging portions of the connecting portions align the first and second members in longitudinal, width and thickness directions of the tape members), and a holding means (44 and 46), wherein the first connecting portion comprises a locking member (43) and the second connecting portion comprises a locked member (44). To modify the tape member of Hamano employing the connecting structure of Busler would have been an obvious substitution of connecting, aligning and holding structures already known in the art, the advantages of connecting and aligning being described by Busler. To provide the connecting portions as integral attached members as opposed to unitary members of the tape would have been an obvious modification of the structural combination, as it has been long held to provide a unitary structure in discrete elements where the elements work the same or similarly has been held to be obvious modification of an existing structure to one of ordinary skill in the art. To have the feed holes extend the entire length of the tape member would provide a feed hole in a positional relationship to a feed hole of an adjacent tape member.

8. Claim 13 is further rejected on the grounds of *res judicata*, as the same claim has been held unpatentable by a decision of the BPAI rendered June 24, 2009.

9. Applicant's arguments filed August 20, 2009 have been fully considered but they are not persuasive in view of the new grounds of rejection. Since applicant and his representatives can not appreciate the extensive new grounds of rejection against

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claims 3 and 14 until they are provided to them, an interview was not deemed proper at this time. Applicant will be granted an interview if so desired after receipt and consideration of the new grounds against claims 3 and 14.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is (571) 272-4555. The examiner can normally be reached on Tuesday through Thursday from 7:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bryon P. Gehman/
Primary Examiner, Art Unit 3728

Bryon P. Gehman
Primary Examiner
Art Unit 3728

BPG